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EXAMINER	
DELCOTTO, GREGORY R	
ART UNIT	**PAPER NUMBER**
1751	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/804,834	FUJII, GARY	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-64 is/are pending in the application.

4a) Of the above claim(s) 32-64 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1,5,7-12,14-16 and 21-31 is/are rejected.

7)☒ Claim(s) 7,13 and 17-20 is/are objected to.

8)☒ Claim(s) 1-64 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 6-04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

HC

DETAILED ACTION

1. Claims 1-64 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-31, drawn to a nail polish remover, classified in class 510, subclass 118.

II. Claims 32-64, drawn to a method of removing nail polish from a surface, classified in class 134, subclass 38.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the invention of Group I can be used in a materially different process such as a in a method of cleaning a semiconductor substrate.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Donna Perdue on May 18, 2005, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-64 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

The use of the trademark "CARBOPOL" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 21, these claims are vague and indefinite in that it is unclear what amount is required to achieve what specific function. Note that, the phrase "effective amount" has been held to be indefinite when the claim fails to state the function which is to be achieved and more than one effect can be implied from the

specification or the relevant art. *In re Fredericksen*, 213 F.2d 547, 102 USPQ 35 (CCPA 1954).

With respect to instant claim 29, it contains the trademark "carbopol"; trademarks are not permitted in the claims and render the claims vague and indefinite in when used to describe a material or product which is the situation in instant claim 29. See MPEP 2173.05(u). Note that, instant claims 2-20 and 22-28 have also been rejected due to their dependency on claims 1 and 21.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 21, 22, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Fusiak (US 5,334,331).

Fusiak teaches an environmentally safe, water-soluble stripping composition comprising between about 30 and about 98.5 wt.% N-methylpyrrolidone or a 10/90 to 90/10 mixture of N-methylpyrrolidone and gamma-butyrolactone and between about 0.1 and about 5 wt.% cyclomethicone. See Abstract. For cost reduction, cosolvents or diluents can be used to extend the stripping composition and reduce formulation cost. Examples of such cosolvents include propylene glycol methyl ether, diethylene glycol ethyl ether, ethylene carbonate, propylene carbonate, etc. See column 3, lines 35-60. Additionally, thickeners can be used in amounts from about 0.5 to about 20 weight

percent and include hydroxypropyl cellulose, ethyl cellulose, methyl cellulose, etc. See column 4, lines 10-30.

Note that, Fusiak teaches that preferred compositions contain 20 to 90% by weight of NMP, 10 to 60% by weight of BLO, 10 to 50 and more preferably, 10 to 20% by weight of cosolvent, 1 to 4% thickening agent, etc. Specifically, Fusiak teaches a composition containing 49.5% NMP, 49.5% BLO, 1% Klucel, etc. See column 6, lines 25-45. Fusiak discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the broad teachings of Fusiak anticipate the material limitations of the instant claims.

Claims 23-27 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fusiak (US 5,334,331).

Fusiak is relied upon as set forth above. Note that, with respect to instant claim 31, the Examiner asserts that the broad teachings of Fusiak et al would suggest formulating compositions in the form of a gel because Fusiak teaches that the amount of thickening agent used in the compositions may be varied. See col. 4, lines 10-25.

However, Fusiak does not teach, with sufficient specificity, a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a remover composition containing N-methyl

pyrrolidone, butyrolactone, ethylene carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Fusiak suggest a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1, 2, 7, 8, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Machac, Jr. et al (US 6,187,108).

Machac, Jr. et al teach a process useful to clean and remove uncured resins. The resins to be treated include epoxy, polyester, and polyurethane foam. The compositions include alkylene carbonate, including propylene and ethylene carbonate. See Abstract. The alkylene carbonate may be present in an amount up to 100 percent by weight, preferably 15 to 75% by weight or 10 to 80% by weight. See column 3, lines 40-60. The compositions may contain a glycol ether such as dipropylene glycol methyl ether, etc., in amounts from 0 to 90% by weight, 5 to 60% by weight, or preferably 10 to 50% by weight. See column 3, line 60 to column 4, line 8. Additionally, the compositions may contain heterocyclic compounds such as N-methyl pyrrolidone in amounts from 0 to 90%, 10 to 60%, and most preferably, 15 to 50%. The composition may also include other solvents such as glycols, butyrolactone, etc. See column 4, line 50 to column 5, line 10. Also, thickeners such as hydroxypropyl cellulose, ethyl cellulose, ethyl hydroxyethyl cellulose, methyl cellulose etc., may be used in the

compositions in amounts from 1 to about 4 percent by weight. See column 5, lines 24-45. Specifically, Machac, Jr. et al teach a cleaning composition containing 25% propylene carbonate, 25% ethylene carbonate, and 50% NMP as well as numerous other examples containing heterocyclic solvents. See column 8, line 10 to column 12, line 69. Machac, Jr. et al disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the broad teachings of Machac, Jr. et al anticipate the material limitations of the instant claims.

Claims 9-12 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machac, Jr. et al (US 6,187,108).

Machac, Jr. et al are relied upon as set forth above. Note that, with respect to instant claim 31, the Examiner asserts that the broad teachings of Machac, Jr. et al would suggest formulating compositions in the form of a gel because Muchac, Jr. et al teaches that the amount of thickening agent used in the compositions may be varied.

However, Machac, Jr. et al do not teach, with sufficient specificity, a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a

reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Machac, Jr. et al suggest a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1, 21, 22, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilkins et al (US 5,215,675).

Wilkins et al teach a water-soluble stripping composition which comprises a solution of between about 1 and about 50 parts by weight of water, between about 1 and about 30 parts by weight of peroxide, and between about 25 and about 95 parts by weight of a water-soluble ester such as butyrolactone, ethylene carbonate, etc., and mixtures thereof. See column 2, lines 1-20. Additionally, for cost reduction, cosolvents may be used such as N-methyl pyrrolidone, propylene glycol, etc. See column 3, lines 40-65. Thickeners may also be used such as cellulose, Carbopol 934 or 940, methylcellulose, etc. See column 4, lines 20-45.

Specifically, Wilkins et al teach a composition containing 42% gamma-butyrolactone, 42% N-methylpyrrolidone, 14% hydrogen peroxide, 1% Klucel, etc. Wilkins et al disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the broad teaching of Wilkins et al anticipates the material limitations of the instant claims.

Claims 24, 26, and 29-31are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins et al (US 5,215,675).

Wilkins et al are relied upon as set forth above. Note that, with respect to instant claim 31, the Examiner asserts that the broad teachings of Wilkins et al would suggest formulating compositions in the form of a gel because Wilkins et al teaches that the amount of thickening agent used in the compositions may be varied.

However, Wilkins et al do not teach, with sufficient specificity, a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, methylcellulose, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, methylcellulose and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teaching of Wilkins et al suggest a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, methylcellulose, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Machac, Jr. et al (US 6,479,445).

Machac, Jr. et al teach a process for removing paint comprising applying a composition containing effective amounts of an organic carbonate, a thickener, hydrogen peroxide, and water to a painted surface. See column 2, lines 1-20. The organic carbonate used may be an alkylene carbonate such as propylene carbonate or ethylene carbonate and may be used in amounts from 0.1 to 90% by weight. See column 3, lines 30-60. Vegetable oils may also be used in the compositions in amounts from 0.1 to 90% by weight. When vegetable oils are used, alkyl soyates such as methyl soyate may be used as an activator and the amount of methyl soyate may be from about 0.1 to about 50 percent by weight of the composition. See column 4, lines 15-69. Suitable thickeners include cellulose ether such as hydroxypropyl cellulose, methyl cellulose, etc. and the thickener may be used in amounts of 1 to about 4% by weight of the composition. See column 5, line 60 to column 6, line 20. A glycol ether may be used to provide a miscible composition in amounts from about 10 to 50 percent by weight. Suitable glycol ethers include dipropylene glycol methyl ether, dipropylene glycol n-butyl ether, etc. See column 5, lines 30-40 and column 7, lines 12-30.

Specifically, Machac, Jr. et al teach paint removing compositions containing varying amounts of propylene carbonate including a composition containing 80% by weight of propylene carbonate. See column 8, lines 45-60. Machac, Jr. et al disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Machac, Jr. et al anticipate the material limitations of the instant claims.

Claim 2 rejected under 35 U.S.C. 102(b) as being anticipated by Machac, Jr. et al (US 6,479,445).

Note that, the Examiner asserts that claims 2-20 have an effective filing date of 3/19/04 due to the inclusion of the newly added subject matter filed in the continuation in part application.

Machac, Jr. et al are relied upon as set forth above.

Machac, Jr. et al disclose the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Machac, Jr. et al anticipate the material limitations of the instant claims.

Claims 2, 4, 5, 7-10, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machac, Jr. et al (US 6,479,445).

Machac, Jr. et al are relied upon as set forth above. However, Machac, Jr. et al do not teach, with sufficient specificity, a composition containing propylene carbonate, Ipropylene glycol methyl ether, methyl soyate, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing propylene carbonate, Ipropylene glycol methyl ether, methyl soyate, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Machac, Jr. et al suggest a composition

containing propylene carbonate, Ipropylene glycol methyl ether, methyl soyate, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1, 21, and 28 rejected under 35 U.S.C. 102(b) as being anticipated by Stevens (US 5,427,710).

Stevens teaches stripping compositions and methods for removing conventional polymeric coatings such as paints, coatings, nail polishes and the like. See column 2, lines 1-12. Solvents such as N-methylpyrrolidone, propylene carbonate, ethylene carbonate, gamma-butyrolactone, etc., may be added to the composition in amounts from about 2% to 70% by weight of the final composition. See column 5, lines 1-15. The compositions may advantageously utilize gel formation to produce a composition exhibiting enhanced stripping activity and acceptable thixotropy and the agents may be used in amounts from 0.005% to about 50% by weight of the composition. Suitable thixotropic agents include hydroxypropyl cellulose, methylcellulose, etc. See column 11, line 25 to column 12, line 5.

Specifically, Stevens teaches a composition containing 3% bentone, 3% ethanol, 10% water, 2% PD-600, 46% methyl pyrollidone, 29% propylene carbonate, and 7% dipentene. Stevens discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Stevens anticipate the material limitations of the instant claims.

Claims 22, 24, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens (US 5,427,710).

Stevens is relied upon as set forth above. However, Stevens does not teach, with sufficient specificity, a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, methylcellulose and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teaching of Wilkins et al suggest a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, methylcellulose, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Monteleone (US 5.258,070).

Monteleone teaches a mixture for the removal of nail lacquer comprising propylene carbonate, propylene glycol, and dimethyl isosorbide and, optionally, dimethylsulfoxide. See Abstract. The most preferred mixtures comprise about 50 to 90% by weight propylene carbonate, about 4 to 35% by weight propylene glycol, about 1 to 39% by weight dimethyl isosorbide and, optionally, about 5 to 30% by weight

DMSO. Specifically, Monteleone teaches a composition containing 5% by weigh dimethyl isosorbide, 10% propylene glycol, 5% water, and 80% propylene carbonate. See column 2, lines 50-69. Monteleone discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Monteleone et al anticipate the material limitations of the instant claims.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Monteleone et al (US 5,258,070) as applied to claims 1 and 2 above, and further in view of WO00/45776.

Monteleone et al are relied upon as set forth above. However, Monteleone et al do not teach the use of Vitamin E in addition to the other requisite components of the composition as recited by the instant claims.

'776 teaches a composition for removal of nail polish, plaster, adhesives, discolorations or other adhesive products on the skin and/or nails, which includes at least 20% of one or more esters or one or more natural oils, which further includes one or more synthetic esters, and which is substantially free from volatile solvents. See Abstract. The composition may also include vitamins such as vitamin A, vitamin B, vitamin D, and vitamin E. Vitamins can also be added in the form of natural oils which are naturally high in nutritional content, e.g. pure oil seed rape oil or another oil, and such an addition of oil can give an extra caring effect on skin/nails. See page 5, lines 20-35.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use vitamin E in the composition taught by Monteleone et al, with a reasonable expectation of success, because '776 teaches the use of vitamin E in a similar nail polish removal composition provides an extra caring effect on skin/nails.

Allowable Subject Matter

Claims 6, 13, and 17-20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the references of record, alone or in combination, teach or suggest the use of vitamin E or canola oil in addition to the other requisite components of the composition in the specific proportions as recited by the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, and 21-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8,

and 9 of copending Application No. 10/394405. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 8, and 9 or copending application 10/394405 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, methylcellulose and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teaching of Wilkins et al suggest a remover composition containing N-methyl pyrrolidone, butyrolactone, ethylene carbonate, methylcellulose, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, and 9 of copending Application No. 10/394405 in view of WO00/45776.

Claims 1, 8, and 9 of 10/394405 suggest the claimed invention with the exception of the inclusion of Vitamin E.

'776 is relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use vitamin E in the composition taught by Monteleone et al, with a reasonable expectation of success, because '776 teaches that the use of vitamin E in a similar nail polish removing composition provides an extra caring effect on skin/nails.

This is a provisional obviousness-type double patenting rejection.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
May 23, 2005